

REMARKS

By this Amendment, Applicant amends claims 1, 3, 9, and 11. Claims 1, 3-9, 11, and 12 remain currently pending.

In the Office Action, the Examiner rejected claims 1, 3-9, 11, and 12 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,144,855 to Slovin (“Slovin”) in view of U.S. Patent Application Publication No. 2005/0221846 to Jansen (“Jansen”) and U.S. Patent No. 5,914,668 to Chavez, Jr. et al. (“Chavez”).¹

Applicant respectfully traverses the rejection of claims 1, 3-9, 11, and 12 under 35 U.S.C. § 103(a) as being unpatentable over Slovin in view of Jansen and Chavez, because a *prima facie* case of obviousness has not been established.

To establish a *prima facie* case of obviousness based on a combination or suggestion of prior art, “Office personnel must articulate . . . a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference.” M.P.E.P. § 2143.A (8th edition, revision 6).

Independent claim 1, as amended,² recites a combination including, for example,

a counting unit configured to count a finding frequency of the wireless relay apparatus found by the finding unit;

. . .

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

² Support for the amendments may be found at, for example, page 7 of the specification.

a storing unit which stores specific image data indicating characters representing identification information of the found wireless relay apparatus; and

a displaying unit configured to display one of characters indicated by the image data stored in the storing unit and representing a character of the identification information of the wireless relay apparatus detected by the detector in a display form which is in accordance with the finding frequency counted by the counting unit.

Slovin, Jansen, and Chavez fail to teach or suggest at least these features of amended claim 1.

The Office Action acknowledges that "Slovin does not expressly disclose a counting unit configured to count a finding frequency of the wireless relay apparatus found by the finding unit," but alleges that "Jansen discloses a counting unit configured to count a finding frequency of the wireless relay apparatus (see paragraph 17, search frequencies and its count values)." (Office Action at 4.) Applicant respectfully disagrees with the allegation.

In the paragraph cited by the Examiner, Jansen explicitly states:

The invention provides, according to a first aspect, a method for initial synchronization in a mobile telecommunications network to connect a mobile terminal to a base station, the mobile terminal having a search frequency list comprising a limited number of search frequencies, the method comprising the step of searching for an available frequency in the order of the search frequency list, the search frequency list further comprising count values, indicating how frequently the corresponding frequency has been used, wherein the order of at least some of the search frequencies depends on the count values.

Jansen, para. [0017], emphasis added. That is, Jansen uses the search frequency list to indicate how frequently a particular frequency of the radio wave is used. Id. Contrary to Jansen, the counting unit as recited in amendment claim 1 counts

"a finding frequency of the wireless relay apparatus found by the finding unit," i.e., the number of times which the wireless relay apparatus is found by the finding unit. Therefore, Jansen's teaching of radio search frequency list clearly does not constitute "a counting unit configured to count a finding frequency of the wireless relay apparatus found by the finding unit," as recited in amended claim 1 (emphasis added). In fact, Slovin, Jansen, and Chavez fail to mention any "finding frequency of the wireless relay apparatus found by the finding unit," as recited in claim 1.

The Office Action also acknowledges that "Slovin and Jansen do not expressly disclose a displaying unit configured to display a specific character of information which is characterized according to the identification information of the wireless relay apparatus in which a user can select," but alleges that "Chavez, Jr. et al. discloses a displaying unit configured to display a specific character of information (see figure 5, column 4, line 56-column 5, line 15)." (Office Action at 4.) Applicant respectfully disagrees with the allegation.

In the portions cited by the Examiner, Chavez explicitly states that

In FIG. 5, the base station identification information gives the actual physical location of the base stations with respect to known building location parameters. . . . The user utilizes cursor control 203 to highlight the most preferred base station and then activates enter button 211. The user next utilizes cursor control 203 to select the second base station. After the user has selected as many base stations as desired, the user highlights done 506 and activates enter button 211.

Chavez, column 4, line 45-column 5, line 9, emphasis added. However, Chavez's teaching of a user's using cursor control 203 to control base station selection does not constitute "a displaying unit configured to display one of characters indicated by the image data stored in the storing unit and representing a character of the identification

information of the wireless relay apparatus detected by the detector in a display form which is in accordance with the finding frequency counted by the counting unit," as recited in amended claim 1 (emphasis added).

Further, the Office Action also alleges that "Slovin discloses . . . a storing unit which stores specific characters representing identification information of the found wireless relay apparatus (see column 5, lines 30-42, access point table stored in memory and figure 1, block 60)." (Office Action at 3.) Applicant respectfully disagrees.

Slovin explicitly states that "[e]ach station 10 also includes a frequency table memory 40 storing a number of frequency tables each of which may be employed by one of the access points. Each access point 20 stores the frequency table 50 which it employs." Slovin, column 5, lines 15-18, emphasis added. Further, Slovin also states that "each station is preferably operative to initially and periodically update the table entries of access points which are in range The information regarding each in-range access point preferably includes . . . access point's ID 70 including the access point's frequency table ID 80 and a time-stamped entry 90 of the selected access point's frequency table." Slovin, column 5, lines 21-32, emphasis added.

However, Slovin's teaching of a frequency table including frequencies employed by the access points does not constitute "a storing unit which stores specific image data indicating characters representing identification information of the found wireless relay apparatus," as recited in amended claim 1 (emphasis added).

Therefore, Slovin, Jansen, and Chavez fail to teach or suggest all elements of amended claim 1, and a *prima facie* case of obviousness has not been established. Accordingly, Applicant respectfully requests withdrawal of the Section 103(a) rejection

of amended claim 1. Because claims 3-8 depend from claim 1, Applicant also requests withdrawal of the Section 103(a) rejection of claims 3-8 for at least the same reasons stated above.

Further, amended independent claim 9, while of different scope, recites similar features to those of amended claim 1. Amended claim 9 is therefore also allowable over Slovin, Jansen, and Chavez for at least the same reasons stated above with respect to amended claim 1. Applicant respectfully requests withdrawal of the Section 103(a) rejection of amended claim 9 and claims 11 and 12, which depend from claim 9.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 7, 2008

By:


Wenye Tan
Reg. No. 55,662
(571) 203-2722